

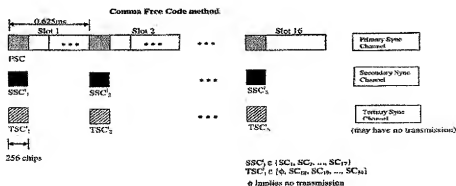
REMARKS

Claims 1-5 and 13-17 are pending in the instant application. Applicant respectfully requests reconsideration and allowance of this application in view of the following remarks.

Claims 1-5 and 13-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Allegedly Admitted Prior Art ("AAPA") in view of U.S. Patent No. 6,233,466, Wong et al. ("Wong"). Applicant respectfully requests that this rejection be withdrawn for reasons including the following, which are presented by way of example.

The applicant contends that the present application claims priority from Ser. No. 09/418,907, filed October 15, 1999, which claims priority from provisional application Ser. No. 60/104,445, filed October 16, 1998. Wong, on the other hand, has a filing date of April 8, 1999 and claims priority to a provisional application filed December 14, 1998. The applicant has relied on the provisional application filing date as being prior to Wong, so that Wong is not available as a reference. The examiner now contends "in particular, applicant's provisional application does not recite the concept or the element, each of a synch code over adjacent channels during a first symbol time in each of said predetermined number of time slots" (referring to independent claims 1 and 13).

Section 2 of the provisional application includes the following figure:



It will be noted that this figure illustrates that each synch code is transmitted over adjacent channels during a first symbol time in each of said predetermined number of time slots. For example, in this illustration FSC, SSC_n^i and TSC_n^i are received in the first 256 chips in Slot 1, in Slot 2, ... Slot 16 in respective primary, secondary, and tertiary synch channels. Accordingly, the provisional application does support the allegedly missing element of "receiving each of a primary, a secondary and a tertiary synchronization code over respective adjacent channels during a first symbol time in each of said predetermined number of time slots" (claim 1) and "transmitting a primary, a secondary, and a tertiary synchronization code over respective adjacent channels during a first symbol time in each of said time slots" (claim 13).

That is, the provisional application provides Section 112, first paragraph support for this recitation. (MPEP 2106.35.) The examiner has the initial burden of presenting evidence of why one of ordinary skill in the art would not recognize that the written description provides support for the claims. The following steps are to be taken (MPEP 2163): (A) for each claim, determine what each claim as a whole covers; (B) review the entire application to understand how the applicant provides support for the claimed invention including each element and/or step; (C) determine whether there is sufficient written description to inform a skilled artisan that the applicant was in possession of the claimed invention as a whole at the time the application was filed. For each claim lacking written description the examiner must:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application.

Here, the examiner merely complies with step (A). However, the office action fails to explain, as required, why a person skilled in the art would not have recognized “receiving each of a primary, a secondary and a tertiary synchronization code over respective adjacent channels during a first symbol time in each of said predetermined number of time slots” (claim 1) and “transmitting a primary, a secondary, and a tertiary synchronization code over respective adjacent channels during a first symbol time in each of said time slots” (claim 13) in the provisional application.

Accordingly, the examiner must establish a proper *prima facie* case as to why the provisional application lacks written description for the claim limitation at issue, or withdraw the rejections under 35 USC 103(a) which rely on Wong.

Although the applicant contends that the rejection must be withdrawn for procedural reasons, the applicant further believes that the office action fails to establish a *prima facie* case of obviousness.

To properly reject a claimed invention, the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, it is necessary to identify the reason why a person of ordinary skill in the art would have combined allegedly known elements in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.* 550 U.S. ___, 82 U.S.P.Q.2d 1385 (2007). The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). The applicant for patent may then attack the *prima facie* case as improperly made out, or present objective evidence tending to support a conclusion of nonobviousness. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir.

1992). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The applicants provide herein a selection of some examples of limitations in the claims which are neither taught nor suggested by AAPA. The final Office Action admits that AAPA “does not specifically disclose and receiving synchronization code over respective adjacent channels during a first symbol time in each of said predetermined number of time slots.” (Final Office Action, page 3). Recognizing that AAPA fails to teach and/or suggest the invention as claimed, Wong is cited to remedy the deficiencies.

Nevertheless, Wong fails to remedy such deficiencies. The office action cites Wong, Col. 6, line 63 to Col. 7, line 6 as being particularly relevant. Wong’s transmission of primary and secondary synchronization codes during a 256 chip interval at the beginning of the time slot, and transmitting the BCCH and PCH channel information during the remainder of the time slot, does not teach or suggest transmitting “a primary, a secondary, and a tertiary synchronization code” “during a first symbol time in each of said time slots.” Wong also fails to teach or suggest other elements recited in the claims.

Hence, AAPA and Wong, alone or in combination, fail to teach or suggest the combination of features recited in the independent claims, when considered as a whole.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from the independent claims, but also because of additional features they recite in combination.

Applicant respectfully submits that, as described above, the cited art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the

cited art shows any of the elements recited in the claims. However, applicant has provided specific examples of elements in the claims that are clearly not present in the cited art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the cited art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicant has provided examples of why the claims described above are distinguishable over the cited references.

In view of the foregoing, the applicant submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Texas Instruments Incorporated's Deposit Account No. 20-0668.

This Amendment is submitted by the undersigned registered patent attorney in accordance with 37 CFR 1.34.

Respectfully submitted,



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